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MAILED
NOV 21 2011
OFFICE OF PETITIONS

In re Patent No. 6,228,074 :
Issue Date: 05/08/2001 :
Application Number: 09/173,422 : DECISION ON PETITION
Filing Date: 10/15/1998 :
For: MULTIPLE PULSE PHOTO- :
EPILATOR :

This is a decision on the petition filed on November 8, 2011, under 37 CFR § 1.378(b) to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued May 8, 2001. The first maintenance fee was timely paid. The second maintenance fee could have been paid from May 8 through November 10, 2008, or, with a surcharge during the period from November 11, 2008, through May 8, 2009.

Accordingly, the patent expired at midnight May 8, 2009, for failure to timely submit the maintenance fee.

Petitioner states that the "the expiration of the '074 patent for failure to pay the 7.5 year maintenance fee was unavoidable and unintentional". In support, petitioners have provided declarations from the inventor, his counsel, and a docketing administrator.

Petitioner, inventor Stephen Almeida, states in his declaration, in pertinent part:

4. I retained, Attorney John C. Serio, on or about October 1998, to draft and file the application that matured into the '074 patent on or about May 8, 2001;
5. On or about October 24, 2006 I sent an email to Attorney John Serio, of Brown Rudnick, asking how maintenance fees for my issued '074 patent would be paid; (attachment A)
6. In a reply to my email of October 24, 2006, Attorney Serio indicated that Brown Rudnick would pay these fees as they became due; (attachment A)
7. On or about May 15, 2007, Attorney Serio informed me via email that he would be leaving Brown Rudnick to join Seyfarth Shaw LLP (Seyfarth Shaw). Attorney Serio indicated that I could either continue my relationship with Brown Rudnick or notify Attorney Sam Williams, of Brown Rudnick, to transfer my patent files to Seyfarth Shaw; (attachment B)
8. On or about May 16, 2007 I sent an email to Sam Williams requesting Brown Rudnick to transfer both my physical and electronic patent files to Seyfarth Shaw; (attachment C)
9. Based upon my transfer instructions, I expected that the files would be transferred to Seyfarth Shaw by Brown Rudnick;
10. I can state unequivocally that I did not intend the '074 patent to expire for failure to pay maintenance fees and that such failure was unintentional and unavoidable ...

Petitioner's counsel, registered patent practitioner John C. Serio, states in his declaration, in pertinent part:

7. On or about May 27, 2007, I accepted an offer to join my present firm, Seyfarth Shaw, in their Boston office to continue my practice in IP law;

8. I joined Seyfarth Shaw with several of my colleagues from the Boston office of Brown Rudnick;

9. In accordance with professional and ethical obligations, my colleagues and I requested that our clients instruct Brown Rudnick to transfer our client's physical and electronic files to our new firm, Seyfarth Shaw;

10. As a result of these transfer requests, Brown Rudnick transferred the physical files of our collective clients, these files amounted to the work product of several attorneys over the period of several decades and totaled in excess of 700 hundred active files and several thousand inactive files;

11. As a further result of these transfer requests, Brown Rudnick transferred the electronic files of our collective clients, these electronic files amounted to the work product of several attorneys over the period of several decades and the respective docketing records for this collective work;

12. To ensure the orderly transfer of these files, we hired our former docketing clerk, June Kaps, who had over seventeen years of experience in the area of administration, procedure and docketing in the patent and trademark field and who had worked with us at Brown Rudnick;

13. Ms. Kaps is very experienced in patent practice and procedure and understands the importance and issues in the docketing of patent applications and issued patents;

14. Ms. Kaps is experienced in the use of electronic and manual patent systems to ensure proper docketing notice to patent practitioners;

15. Immediately upon our arrival at Seyfarth Shaw, Ms. Kaps began the process of receiving and docketing the physical files sent to us by Brown Rudnick at the request of our respective clients;
16. Our former firm, Brown Rudnick, had a professional file room manager who was responsible for ensuring the transfer of our clients' files;
17. In order to ensure that the importance of our clients' matters were protected, we contracted with the patent docketing software company, CPI, to additionally have an electronic transfer of our clients' docket entries as requested by their transfer instructions;
18. We believed that the steps taken during the transfer of files had redundancy to ensure our important client matters would be protected in the form of not only the receipt of physical files, but the receipt of corresponding electronic docket entries.
19. On or about September 1, 2011, Ms. Kaps received an email from the docketing clerk at Brown Rudnick that contained a Patent Expiration Notice for U.S. Patent 6,595,986 "Expired Patent"). The expiration was based upon the failure to pay maintenance fees (Kaps dec., Attachment D).
20. The Expired Patent was a CIP application of the above-captioned patent ("Petition Patent") for a client, Stephen Almeida, who had requested that Brown Rudnick transfer its files to Seyfarth Shaw on or about May 16, 2007 (Kaps Decl., Attachment B);
21. Upon receiving this Expiration Notice, Ms. Kaps brought this notice to the undersigned's attention;
22. We conducted an investigation and found that we did not possess the physical file nor the electronic file associated with this patent and that the patent was therefore not entered into our docketing system;
23. Based upon the receipt of the Expiration Notice we immediately filed a petition, under 37 CFR 1.378 (c), which was granted;

24. Shortly after receipt of the Expiration Notice, the undersigned attorney, our file room manager (Edwin Colon), and Ms. Kaps diligently searched our file room for other patents related to our client's Expired Patent.

25. During the course of our investigation we discovered that the Petition Patent for this Expired Patent was also not in our physical presence or docketing system;

26. Upon inquiry to the USPTO PAIR system we discovered that the Petition Patent had also expired for failure to pay maintenance fees. As part of our investigation, we requested the file wrapper of the Petition Patent to see where the Notice of Expiration was sent;

27. As with the Expired Patent, the Expiration Notice was sent to our former firm Brown Rudnick on or about June 8, 2009, however, this notice was not forwarded to us, as had been the case of the Expired Patent (Kaps Decl., Attachment F);

28. A double-docketing system is maintained by the undersigned attorney. One system is maintained with the aid of a computer and the other is a manual system. Accordingly, because of the failure to receive the physical or electronic files, despite our client's instructions, neither of the two docket systems recorded the existence of the Expired Patent and its related Petition Patent.

29. Since the undersigned attorney never received the physical file and its electronic counterpart, I did not receive the patent maintenance fee reminder and the subsequent Notice of Patent Expiration. Thus, I had no notice of the fees that were due. Accordingly, it is submitted that any abandonment of this application was unintentional and unavoidable and it is respectfully requested that this Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent under 37 CFR 1.378(b) be granted.

Petitioners have also provided a declaration of Julie Kaps, docket administrator for Seyfarth Shaw, LLP, in which she states, in pertinent part:

8. In 2007 three attorneys from Brown Rudnick moved to the Boston law firm of Seyfarth Shaw to start an IP department.

9. Approximately two weeks before any of the three Brown Rudnick attorneys arrived at Seyfarth Shaw, I joined Seyfarth Shaw to oversee and effect availability of docketing resources in the Seyfarth Shaw Boston office;

10. Before the first attorney arrived, I made sure the Boston attorneys would have Computer Packages Inc. (CPI) docketing available;

11. Upon resignation from Brown Rudnick, the three attorneys received and provided me a hard copy docket printout for the next six months;

12. Physical files from Brown Rudnick arrived at Seyfarth Shaw in batches as clients authorized transfer;

13. As each physical file arrived at Seyfarth Shaw, I opened new client/matter numbers, organized files into a file room, prepared power of attorney forms, obtained signatures from clients, electronically filed Powers of Attorney and change of correspondence addresses with the U.S. Patent & Trademark Office, and checked for impending actions in those cases and against the hard copy docket received from Brown Rudnick;

14. Despite having engaged our docketing service provider, CPI, early in the process to provide an electronic records data dump from the Brown Rudnick database, it took several weeks to receive the Brown Rudnick data from CPI into Seyfarth Shaw's CPI electronic docketing system;

15. Once CPI electronic data was received and loaded onto Seyfarth Shaw's system and available in Boston, I cross-checked the Seyfarth Shaw electronic docket data against the hard copy data provided by Brown Rudnick. I updated Seyfarth Shaw's received CPI electronic docket and data with any changes/actions taken in the interim;

16. I further cross-checked the information in all active physical files against the received CPI electronic docket data, and changed Brown Rudnick case numbers to the new Seyfarth Shaw case numbers;

17. To my knowledge all physical files sent from Brown Rudnick and received at Seyfarth Shaw Boston were properly docketed on the Seyfarth Shaw CPI docketing system;

18. For a period of time, Brown Rudnick forwarded all mail and any U.S. Patent & Trademark Office correspondence they received for the three attorneys that joined Seyfarth Shaw;

19. On or about September 1, 2011, I received an email from an assistant at Brown Rudnick, containing a Patent Expiration Notice for U.S. Patent 6,595,986 ('986 Expired Patent). The expiration was based upon the failure to pay maintenance fees (Attachment D hereto).

20. The '986 Expired Patent was a Continuation-In-Part (CIP) application of the above captioned '074 patent for a client, Stephen Almeida (Brown Rudnick client number 21221), who had requested that Brown Rudnick transfer its files to Seyfarth Shaw on or about May 16, 2007 (Attachment C);

21. John Serio, Edwin Colon (of Seyfarth Shaw's Records Department) and I conducted a thorough investigation and found that we did not possess the physical file nor the electronic file associated with the '986 Expired Patent and that the patent was therefore not entered into our docketing system;

23. Upon inquiry to the USPTO PAIR system I discovered that the '074 Petition Patent had also expired for failure to pay maintenance fees. As part of our investigation, we requested the file wrapper for the '074 Petition Patent to see what address the Maintenance Fee Reminder and the Notice of Expiration were sent to; (Attachment E & F);

24. The notice for the '074 Petition Patent was sent to our former firm Brown Rudnick on or about June 8, 2009 (as with the '986 Expired Patent) and a previously sent Maintenance Fee Reminder was sent on or about November

17, 2008. However, neither the reminder nor the notice was forwarded to us, as had been the case of the '986 Expired Patent;

25. As part of our investigation I requested that CPI provide us with a list of the clients that were included in the data dump from Brown Rudnick in 2007;

26. Brown Rudnick case number 21221 was not in the data dump even though the client had requested that their information be transferred (Attachment G);

27. Physical files for Brown Rudnick case number 21221 were also apparently not received at Seyfarth Shaw during the transfer of files in 2007.

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

This petition lacks requirement (1).

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").¹ Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.² In this regard:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by

¹ Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

² Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.³

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".⁴ A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."⁵ This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."⁶ Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.⁷ Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.⁸ However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or

³ In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

⁴ 35 U.S.C. § 41(c)(1).

⁵ Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

⁶ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

⁷ In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

⁸ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

her burden of establishing the cause of the unavoidable delay.⁹ In view of In re Patent No. 4,409,763, this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

This petition does not satisfy the requirement of 37 CFR 1.378(b)(3). The statements presented in the petition do not rise to the level of the showing required to establish unavoidable delay within the meaning of 37 CFR 1.378(b).

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.¹⁰ That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.¹¹

With regard to period (1), above, a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(1) the error was the cause of the delay at issue;

(2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance;

(3) and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.¹²

An adequate showing requires:

(A) Statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them.

⁹ Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

¹⁰ Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

¹¹ Id.

¹² See MPEP 711.03(c)(III)(C)(2).

(B) Petitioner must supply a thorough explanation of the docketing and call-up system in use and must identify the type of records kept and the person responsible for the maintenance of the system. This showing must include copies of mail ledgers, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due.

(C) Petitioner must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

In essence, petitioners assert a docketing error in the transfer of the maintenance fee tracking information from the docketing system of the prior firm, Brown Rudnick Berlack Israels LLP (hereinafter "Brown Rudnick"), to the docketing system of the current firm of Seyfarth Shaw, LLP (hereinafter "Seyfarth Shaw").

However, petitioners have not provided a sufficient showing of a docketing error. Petitioners allege, in the Kaps declaration, that the physical and electronic files for the subject patent was not received by Seyfarth Shaw from Brown Rudnick.¹³

If the error occurred because of a failure on the part of personnel at Brown Rudnick to transfer the subject data and physical patent files to the docketing system of Seyfarth Shaw, petitioners must identify the clerical employee(s) at Brown Rudnick who was responsible for transferring the electronic and physical data files. Petitioners must identify the error which led to the delay in payment of the maintenance fee, and explain why this error occurred. Statements by all persons with first-hand knowledge of the error which resulted in the subject patent not being docketed for payment of the second maintenance fee must be provided.

Put another way, petitioners must show that, at both Brown Rudnick and Seyfarth Shaw, there was in place a business routine for performing the clerical function of transferring the data from Brown Rudnick to Seyfarth that could reasonably be relied upon to avoid errors in its performance. Petitioners must identify the clerical error that was the cause of the delay at

¹³ Kaps decl. Paragraphs 26 & 27.

issue and explain how, despite the existence of business route for performing this clerical function that could reasonably be relied upon to avoid errors in its performance, said error nevertheless occurred. Furthermore, petitioners must supply a through explanation of the system in use with regard to the transfer of files from Brown Rudnick to Seyfarth Shaw. In essence, petitioners must provide evidence that a reliable system was in place for transferring this data. This showing must include copies of mail ledgers, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due.

Likewise, petitioners must show that the employees, at both Brown Rudnick and Seyfarth Shaw, were sufficiently trained and experienced with regard to the function and routine of the data transfer from Brown Rudnick to Seyfarth Shaw, and docketing at Seyfarth Shaw, that reliance upon such employees represented the exercise of due care. In this regard, petitioners must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

With regard to petitioner Almeida's assertion that he expected that the files would be transferred from Brown Rudnick to Seyfarth Shaw, while petitioner alleged chose to rely upon his registered patent practitioner ("Serio"), such reliance *per se* does not provide petitioner with a showing of unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 U.S.C. § 41(c). Rather, such reliance merely shifts the focus of the inquiry from petitioner to whether the attorney or agent acted reasonably and prudently. As such, assuming that the agent had been so engaged, then it is incumbent upon petitioner to demonstrate, via a documented showing, that the attorney or agent had docketed this patent for the second maintenance fee payment in a reliable tracking system. If petitioner cannot establish that the attorney or agent had been so engaged, then petitioner will have to demonstrate what steps were established by petitioner to monitor and pay the maintenance fee.

In summary, the showing of record is inadequate to establish unavoidable delay. Petitioner has provided insufficient evidence to substantiate a claim of docketing error. Rather, the showing of record is that petitioners failed to properly transfer the docketing information from Brown Rudnick and/or docket the second

maintenance fee in a reliable tracking system at Seyfarth Shaw. As petitioner has not shown that it exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.¹⁴

Receipt of the payment of \$400.00 is acknowledged. The surcharge due under § 1.20(i)(1) is \$700.00, and the second maintenance fee due (small entity) is \$1,425.00. The balance due of \$1,725.00 (1425 + 700 - 400) will be charged to counsel's deposit account.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The \$400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

A reply may also be filed using the EFS-Web system of the USPTO.

Telephone inquiries should be directed to the undersigned at 571-272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

¹⁴ See note 4, supra.